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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,288	06/01/2005	Bertrand Piot	271640US0PCT	1851
22850	7590	10/06/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
GEORGE, KONATA M				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
10/06/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/537,288

Applicant(s)

PIOT, BERTRAND

Examiner

KONATA M. GEORGE

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19, 20, 22-40 and 42-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 20, 23-32, 36-40 and 42-52 is/are rejected.
- 7) ☒ Claim(s) 22 and 33-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 19, 20, 22-40 and 42-52 are pending in this application.

Action Summary

Any rejections of record that are not repeated below are considered withdrawn.

Allowable Subject Matter

The indicated allowability of claims 19, 20, 23-30, 32-40 and 42-52 is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19, 20, 23-32, 36-40 and 42-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ajinomoto Co. Inc. (EP 0 538 764 A1).

***Determination of the scope and content of the prior art
(MPEP §2141.01)***

Ajinomoto Co. Inc. teaches in Table 6, page 8, a composition comprising a physiologically acceptable medium (36.95% of pure water), at least one alkyl para-hydroxybenzoate (ethyl and propyl para-hydroxybenzoate 0.03% and 0.02% respectively), and at least one lipophilic amino acid derivative (5.0 % of ester D as defined as N-lauroyl-N-methyl- β -alanine as described in preparation example 4, page 5). It is taught that after components 1 and 2 were mixed a powder of adrenocortical hormone was added.

***Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)***

Ajinomoto Co. Inc. does not teach use of a wax in the composition or the concentrations of the particles or the claimed ratio of the para-hydroxybenzoate to the lipophilic amino acid ester.

***Finding of prima facie obviousness
Rational and Motivation (MPEP §2142-2143)***

Although Ajinomoto Co. Inc. does not teach the use of waxes in the composition by way of an example, the specification teaches that waxes can be used. Page 3, lines 19-24 of Ajinomoto teach a group of compounds that can be used as a substitute for an oily base, such as animal and vegetable oils, waxes (beeswax or carnauba wax), mineral oil, silicone oils, vaseline, synthetic oils, etc. It is the position of the examiner

that all of the compounds listed could be used interchangeably with a reasonable expectation of achieving the same results. Since, table 6 teaches that Vaseline can be incorporated into the composition; one of ordinary skill in the art would have been motivated to substitute a wax for the Vaseline in the preparation to achieve the desired results of the composition. Table 7 teaches that the drug can be added ad lib to the O/W emulsion base. It is the position of the examiner that adding the drug ad lib allows one of ordinary skill in the art to add as little or as much of the powdered drug necessary to elicit a response of the drug.

With respect to the claimed ratio this determination would have been made through routine experimentation to achieve the desired results of the claimed invention. This is in the absence of any clear showing of unexpected results attributable to the specific ratio of the para-hydroxybenzoate to the lipophilic amino acid ester of the as employed by applicant in the instant case.

Allowable Subject Matter

Claims 22 and 33-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach the amino acid ester as isopropyl-N-lauroylsarcosinate as taught in claim 22 and the prior art does not teach the solid particles selected from silk fibers, cotton fibers, wool fibers, etc. as taught in claims 33-35.

Conclusion

Claims 19, 20, 23-32, 36-40 and 42-52 are rejected.

Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Konata M. George/
Primary Examiner, Art Unit 1616